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09/683,972	03/07/2002	Klaus Kursawe	CH920000068US1	9293
48915 7590 11/28/2008 CANTOR COLBURN LLP-IBM YORKTOWN 20 Church Street 22nd Floor Hartford, CT 06103				
EXAMINER APPLE, KIRSTEN SACHWITZ				
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10 BEFORE THE BOARD OF PATENT APPEALS
11 AND INTERFERENCES
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14 *Ex parte* KLAUS KURSAWE
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17 Appeal 2008-3808
18 Application 09/683,972
19 Technology Center 3600
20

21 Decided: November 25, 2008
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25 Before HUBERT C. LORIN, ANTON W. FETTING, and JOSEPH A.
26 FISCHETTI, *Administrative Patent Judges*.
27 FETTING, *Administrative Patent Judge*.

28 DECISION ON APPEAL

29 STATEMENT OF CASE

30 Klaus Kursawe (Appellant) seeks review under 35 U.S.C. § 134 of a final
31 rejection of claims 1, 2, 4-7, and 9-20, the only claims pending in the application
32 on appeal.

We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

We AFFIRM.

The Appellant invented a way of informing the account holder about a status of his credit card account (Specification 1:¶ 0001).

An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below [bracketed matter and some paragraphing added].

1. A method of providing information (Z) indicative of an account status to an account holder via a device connected to a network, comprising the steps of:

[1] comparing an actual value (a) with a preset parameter at an account server,

the preset parameter defined by the account holder;

[2] deriving the information (Z)

in response to a transaction (n) that influences the actual value (a),

the transaction (n) occurring between an account user and a purchasing entity; and

[3] providing the information (Z) to the account holder through the device,

the device associated with the account holder;

[4] wherein the information (Z) includes an account balance.

This appeal arises from the Examiner's Final Rejection, mailed March 9, 2006. The Appellant filed an Appeal Brief in support of the appeal on January 17, 2007.

An Examiner's Answer to the Appeal Brief was mailed on August 13, 2007. A
Reply Brief was filed on October 15, 2007.

PRIOR ART

The Examiner relies upon the following prior art:

Joao	US 5,878,337	Mar. 2, 1999
Camacho	US 2003/0208684 A1	Nov. 6, 2003
Stoutenburg	US 6,827,260 B2	Dec. 7, 2004

REJECTION

Claims 1, 2, 4-7, and 9-20 stand rejected under 35 U.S.C. § 103(a) as
unpatentable over Joao, Camacho, and Stoutenburg.

ISSUES

The issue pertinent to this appeal is whether the Appellant has sustained its
burden of showing that the Examiner erred in rejecting claims 1, 2, 4-7, and 9-20
under 35 U.S.C. § 103(a) as unpatentable over Joao, Camacho, and Stoutenburg.

The pertinent issue turns on whether Joao and Camacho describe the
limitations [1] – [3] of claim 1.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported
by a preponderance of the evidence.

Joao

01. Joao is directed to providing notification and security in the use of a
credit or debit card (Joao, col. 1, ll. 8-16).

02. Joao describes performing a test in order to determine if the maximum credit, charge or debit account limit has been exceeded and/or if the card has been depleted of its currency value (Joao, col. 5, ll. 40-51).

03. Joao describes programming so as to limit and/or restrict the amounts and/or types of transactions, and/or the goods and/or services which may be purchased with a card, the stores or service providers which may be authorized to accept the card, limits on the dollar amounts of transactions pertaining to each authorized vendor, seller and/or service provider, daily spending limits, and/or the geographical area or location to which authorized use may be limited, and/or authorized times for card usage (Joao, col. 7, ll. 48-64).

Camacho

04. Camacho is directed to detecting and reducing fraudulent use in e-commerce by using Personal Digital Identification (PDI) techniques (Camacho 1:¶ 0003). It does so by authenticating transactions conducted by an individual or agent by comparing biometric data and profiles to known templates previously provided to the system. If transaction authentication cannot be achieved, business rules of the apparatus are used to determine successive action (Camacho 1:¶ 0014).

05. Camacho describes accepting a purchase request from authorized electronic storefront sites. The request is first processed to ensure that business-filtering rules are applied to the transaction, which quickly identifies those transactions that warrant further authentication, or which may be immediately rejected by the system. After the request is evaluated, an Identity Manager ensures that the required information is

1 available to properly identify the consumer and ensure that registration
2 information is available. After that, a Transaction Rules Manager then
3 processes the request. For example, the Transaction Rules Manager may
4 determine if authentication is required and, if so, what type should be
5 requested of the consumer (Camacho 4:¶ 0042).

6 06. Camacho describes checking the monetary amount of a current
7 transaction against the configurable System Maximum Allowable
8 Amount. If the Transaction Monetary Amount does not exceed the
9 System Maximum Allowable Amount, then processing continues by
10 checking whether Consumer Imposed Registration Limits exist
11 (Camacho 8:¶ 0078). If Consumer Imposed Registration Limits exist,
12 then the monetary amount of the current transaction is tested, and if it
13 exceeds the Per Transaction Limit, then a redirection request to a
14 configurable dynamic web page is returned (Camacho 8:¶ 0079).

15 *Stoutenburg*

16 07. Stoutenburg is directed to facilitating transactions with one of more
17 transaction systems (Stoutenburg, col. 1, ll. 26-29).

18 08. Stoutenburg describes sending an account balance with other
19 information to a point of sale after entering account information
20 (Stoutenburg, col. 33, ll. 48-55).

21 *Facts Related To The Level Of Skill In The Art*

22 09. Neither the Examiner nor the Appellant has addressed the level of
23 ordinary skill in the pertinent arts of systems analysis and programming,
24 financial transaction systems, financial transaction protocol design, and
25 data communications. We will therefore consider the cited prior art as

representative of the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error ‘where the prior art itself reflects an appropriate level and a need for testimony is not shown’”) (quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985).

Facts Related To Secondary Considerations

10. There is no evidence on record of secondary considerations of non-obviousness for our consideration.

PRINCIPLES OF LAW

Claim Construction

During examination of a patent application, pending claims are given their broadest reasonable construction consistent with the specification. *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969); *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364, (Fed. Cir. 2004).

Limitations appearing in the specification but not recited in the claim are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003) (claims must be interpreted “in view of the specification” without importing limitations from the specification into the claims unnecessarily).

Although a patent applicant is entitled to be his or her own lexicographer of patent claim terms, in *ex parte* prosecution it must be within limits. *In re Corr*, 347 F.2d 578, 580 (CCPA 1965). The applicant must do so by placing such definitions in the Specification with sufficient clarity to provide a person of ordinary skill in the art with clear and precise notice of the meaning that is to be

1 construed. *See also In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994) (although
2 an inventor is free to define the specific terms used to describe the invention, this
3 must be done with reasonable clarity, deliberateness, and precision; where an
4 inventor chooses to give terms uncommon meanings, the inventor must set out any
5 uncommon definition in some manner within the patent disclosure so as to give
6 one of ordinary skill in the art notice of the change).

7 *Obviousness*

8 A claimed invention is unpatentable if the differences between it and the
9 prior art are “such that the subject matter as a whole would have been obvious at
10 the time the invention was made to a person having ordinary skill in the art.” 35
11 U.S.C. § 103(a) (2000); *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1729-30
12 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

13 In *Graham*, the Court held that that the obviousness analysis is bottomed on
14 several basic factual inquiries: “[(1)] the scope and content of the prior art are to be
15 determined; [(2)] differences between the prior art and the claims at issue are to be
16 ascertained; and [(3)] the level of ordinary skill in the pertinent art resolved.” 383
17 U.S. at 17. *See also KSR Int’l v. Teleflex Inc.*, 127 S.Ct. at 1734. “The
18 combination of familiar elements according to known methods is likely to be
19 obvious when it does no more than yield predictable results.” *KSR*, at 1739.

20 “When a work is available in one field of endeavor, design incentives and
21 other market forces can prompt variations of it, either in the same field or a
22 different one. If a person of ordinary skill can implement a predictable variation, §
23 103 likely bars its patentability.” *Id.* at 1740.

24 “For the same reason, if a technique has been used to improve one device,
25 and a person of ordinary skill in the art would recognize that it would improve

1 similar devices in the same way, using the technique is obvious unless its actual
2 application is beyond his or her skill.” *Id.*

3 “Under the correct analysis, any need or problem known in the field of
4 endeavor at the time of invention and addressed by the patent can provide a reason
5 for combining the elements in the manner claimed.” *Id.* at 1742.

6 ANALYSIS

7 *Claims 1, 2, 4-7, and 9-20 rejected under 35 U.S.C. § 103(a) as unpatentable over*
8 *Joao, Camacho, and Stoutenberg.*

9 *Claims 1, 2, 7, and 9-14*

10 The Appellant argues claims 1 and 11-13 as a group (App. Br. 6). The
11 Appellant provides no separate arguments for the support of claims 2, 7, 9, 10, and
12 14. Accordingly we treat claims 1, 2, 7, and 9-14 as a group.

13 Accordingly, we select claim 1 as representative of the group.
14 37 C.F.R. § 41.37(c)(1)(vii) (2007).

15 The Examiner found that Camacho described the comparison of limitation [1];
16 Joao described deriving and providing information of limitations [2] and [3]; and
17 Stoutenburg described the balance limitation [4] of claim 1 (Ans. 3-4). The
18 Examiner implicitly found that one of ordinary skill understood the benefits of
19 Camacho’s central decision making to Joao’s prior authorization, and the benefits
20 of seeing Stoutenburg’s balance.

21 The Appellant contends that the only actual value described by Camacho that
22 would describe limitation [1] relates directly to authentication of the requesting
23 party (App. Br. 7:First full ¶). The Appellant infers from this that combining Joao
24 with Camacho would result in deriving purchase information in response to a

1 transaction that influences authentication information (App. Br. 7:Bottom ¶). The
2 Appellant concludes this would not result in claim 1, but the Appellant does not
3 explain how it would differ from claim 1. The Appellant appears to clarify this in
4 the Reply Brief by stating that a parameter associated with such a value would not
5 be defined by the account holder (Reply Br. 2).

6 We disagree with the Appellant. As the Examiner replied, Camacho describes
7 using business filtering rules and transaction rules such as company level rules
8 which go beyond mere authentication (Ans. 6). Camacho compares values in each
9 of a set of business filtering rules, identity manager, and a set of transaction rules
10 (FF 05). This is done both to authenticate and to determine subsequent actions (FF
11 04). Among those parameters used are Consumer Imposed Registration Limits on
12 the monetary amount (FF 06), which as the name implies, is customer imposed, i.e.
13 defined. Such a rule would be consistent with Joao's comparison of monetary
14 limits (FF 02), from which one of ordinary skill would predictably follow to derive
15 and produce the information in limitations [2] and [3]. We also find that the
16 transaction involved necessarily influences the monetary amount as required by
17 limitation [2].

18 *Claims 4, 16, and 18*

19 Claims 4, 16, and 18 are argued together. Claim 4 requires that the preset
20 parameter comprises a limit. The Examiner found this in Joao (Ans. 5). The
21 Appellant argues the preset parameter found by the Examiner would have to be one
22 directed to authentication (App. Br. 8:Second full ¶). We disagree that this
23 demonstrates Examiner error. As the Examiner replied, Joao describes using limits
24 for such parameters (Ans. 8; FF 03). For such parameters to be used for Joao's
25 tests, they would necessarily be preset.

Claims 5, 17, and 20

Claims 5, 17, and 20 are argued together. Claim 5 requires that the preset parameter comprises a geographic region. The Examiner found this in Joao (Ans. 5). Appellant argues the preset parameter found by the Examiner would have to be one directed to authentication (App. Br. 8:Bottom ¶). We disagree that this demonstrates Examiner error. As the Examiner replied, Joao describes using geographic areas for such parameters (Ans. 8; FF 03). For such parameters to be used for Joao's tests, they would necessarily be preset.

Claim 6

Claim 6 is argued separately. Claim 6 requires setting multiple parameters for contemporaneous use. The Examiner found this in Joao (Ans. 5). Appellant argues the preset parameter found by the Examiner would have to be one directed to authentication and that Joao is devoid of multiple parameters for contemporaneous use (App. Br. 9:First full ¶). We disagree that this demonstrates Examiner error. As the Examiner replied, Joao describes using multiple such parameters (Ans. 8; FF 03). For such parameters to be used for Joao's tests, they would necessarily be preset. The Appellant does not provide any argument explaining the allegation that Joao is devoid of multiple parameters for contemporaneous use, and we find that such parameters, such as temporal and geographic parameters, to limit the amounts and types of goods are described by Joao (FF 03). The use of the term "and/or" by Joao implies contemporaneous use.

Claims 15 and 19

Claims 15 and 19 are argued together. Claim 15 requires the limit be a spending limit. The Examiner found this in Joao (Ans. 6). Appellant argues the preset parameter found by the Examiner would have to be one directed to

1 authentication and that Joao is devoid of a preset spending limit parameter (App.
2 Br. 9:First full ¶). We disagree that this demonstrates Examiner error. As the
3 Examiner replied, Joao describes using spending amount parameters (Ans. 8-9; FF
4 03). For such parameters to be used for Joao's tests, they would necessarily be
5 preset. The Appellant does not provide any argument explaining the allegation that
6 Joao is devoid of a preset spending limit parameter, and we find that such a
7 parameter is described by Joao as limits on dollar amounts (FF 03).

8 The Appellant has not sustained its burden of showing that the Examiner erred
9 in rejecting claims 1, 2, 4-7, and 9-20 under 35 U.S.C. § 103(a) as unpatentable
10 over Joao, Camacho, and Stoutenberg.

11 CONCLUSIONS OF LAW

12 Joao and Camacho describe the limitations [1] – [3] of claim 1, as well as the
13 remaining limitations argued by the Appellant. The Appellant has not sustained its
14 burden of showing that the Examiner erred in rejecting claims 1, 2, 4-7, and 9-20
15 under 35 U.S.C. § 103(a) as unpatentable over the prior art.

16 DECISION

17 To summarize, our decision is as follows:

- 18 • The rejection of claims 1, 2, 4-7, and 9-20 under 35 U.S.C. § 103(a) as
19 unpatentable over Joao, Camacho, and Stoutenberg is sustained.

20 No time period for taking any subsequent action in connection with this appeal
21 may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

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LV:

CANTOR COLBURN LLP-IBM YORKTOWN
20 Church Street
22nd Floor
Hartford, CT 06103